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10/027,607	12/19/2001	Kenneth W. Aull	15-0254	3015

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EXAMINER

KHOSHNOODI, NADIA

ART UNIT PAPER NUMBER

2133

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,607

Applicant(s)

AULL ET AL.

Examiner

Nadia Khoshnoodi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/23/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendments with respect to amended claims 2 & 12 and previously presented claims 1, 3-11, and 13-20 filed 6/23/2005 have been fully considered, however the Affidavit relied upon to disqualify Burn, US Pub. No. 2003/0005291 (herein after "Burn") and Hericourt et al., US Pub. No. 2002/0078347 (hereinafter "Hericourt") as prior art is ineffective as explained further below. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

The affidavit filed on 6/23/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Burn and Hericourt references.

MPEP Section 715.04 states that:

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **> If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.< .

(D) The assignee or other party in interest when it is not possible to produce the affidavit

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or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903.

In this case, only one inventor, and not the all of the Inventors of the claimed subject matter made the affidavit with no explanation as to why the other Inventors did not make one. Thus, the affidavit as filed is not effective to overcome the Burn and Hericourt references and therefore the Examiner maintains the previous prior art rejection. This is not meant to be an exhaustive list of the Affidavit's deficiencies, thus the Examiner invites the Applicants to review MPEP 715.01-715.10 to ensure that the Affidavit filed constitutes the key elements in order to overcome the prior art.

Previous Drawing objections with regards to Fig. 1 have been withdrawn due to the Drawing and Specification amendments filed on 6/23/2005. Previous claim objections with regards to claims 2, 4-5, and 12 have also been withdrawn.

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

II. Claims 1 and 11 is rejected under 35 U.S.C. 102(e) as being fully anticipated by Burn, United States Pub. No. 2003/0005291.

As per claim 1:

Burn teaches a token issuance and binding process comprising: providing a plurality of

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tokens, each token having a unique ID number stored therein (par. 6, lines 1-7 and par. 37, lines 1-3); generating a unique public/private key pair for each token (par. 36, lines 8-15); storing each token ID number and corresponding public key in a directory/database (par. 36, lines 16-19); storing each private key in its respective token (par. 36-37 and table 1, field name "User Certificate"); and binding a unique ID number of a user to a corresponding one of the plurality of tokens by storing said correspondence there between in the directory/database (par. 36-37 and fig. 5, element 140).

As per claim 11:

The limitations in claim 11 are similar in scope to the limitations disclosed in claim 1, thus it is rejected for the same reasons since it is merely the system that implements the rejected method claim.

Claim Rejections - 35 USC § 103

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 2-4, 9-10, 12-14, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burn, United States Pub. No. 2003/0005291.

As per claim 2:

Burn substantially teaches the process as applied to claim 1 above. Furthermore, Burn teaches the binding comprising forwarding the user ID number and token ID number to a CMS

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(Certificate Management System) along with E-form request and signature of the Tokenizing Officer (par. 41). Not explicitly disclosed by Burn is a Tokenizing Officer reviewing credentials of a user. However, Burn teaches the HTP & web browser and Certificate Authority carrying out these tasks, thereby acting as the "Tokenizing Officer" and the "Certificate Management System." Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to have the HTP, web browser, and java applet interacting together to form the tokenizing officer, while the Certificate Authority acts as the certificate management system. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 41-43.

As per claim 3:

Burn substantially teaches the process as applied to claim 2 above. Not explicitly disclosed by Burn et al. is the binding further comprising the CMS checking for redundant user tokens and revoking any such user tokens. However, in an alternative embodiment, Burn teaches that each HTP must be initialized distinctly and uniquely to be able to ensure the HTP being enrolled is the correct one. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate the ability to check and revoke any such tokens that are not distinct. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 47.

As per claim 4:

Burn substantially teaches the process as applied to claim 3 above. Furthermore, Burn

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teaches the binding further comprising the CMS filling in the E-form from its directory/database and forwarding the filled in E-form to the Tokenizing Officer (par. 44).

As per claim 9:

Burn teaches the process as applied to claim 1 above. Not explicitly disclosed by Burn is the process wherein providing a plurality of tokens comprises providing a plurality of USB (Universal Serial Bus) tokens. However, Burn teaches the use of a hardware token that could be implemented in various ways. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to have the hardware tokens comprise of USB tokens. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 46.

As per claim 10:

Burn teaches the process as applied to claim 1 above. Not explicitly disclosed by Burn is the process wherein providing a plurality of tokens comprises providing a plurality of smart cards. However, Burn teaches that a smartcard could be used in an alternate embodiment. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to have the hardware tokens comprise of smartcards. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 31.

As per claims 12-14 and 19-20:

The limitations in claims 12-14 and 19-20 are similar in scope to the limitations disclosed

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in claims 2-4 and 9-10, thus it are rejected for the same reasons since they are merely components of the system that implement the rejected method claims.

V. Claims 5-8 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burn, United States Pub. No. 2003/0005291 as applied to claim 4 above, and further in view of Hericourt et al. (U.S. Pub. No. 2002/0078347).

As per claim 5:

Burn substantially teaches the process as applied to claim 4 above. Not explicitly disclosed by Burn is the binding further comprising the Tokenizing Officer reviewing data in filled in E-form and comparing against user credentials and returning same to CMS after signing. However, Hericourt et al. teach a certificate checker to verify the CA and the information received from it. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate, into the HTP, the ability to verify the information received from the CMS in order to validate the CA and the user credentials filled in using the database. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Hericourt et al., par. 3-4 and 80-82.

As per claim 6:

Burn and Hericourt et al. substantially teach the process as applied to claim 5 above. Furthermore, Burn teaches generating and wrapping at least a signature certificate/private and associated private key for the user in the unique public key of the token and returning same to the Tokenizing Officer (par. 44, lines 1-13). Not explicitly disclosed by Burn or Hericourt et al. is the binding further comprising the CMS validating the Tokenizing Officer's signature. However,

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Burn teaches that when the CA receives a message from the HTP it must be decrypted, hence verified. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate the ability to validate the HTP's signature. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 44, lines 1-5.

As per claim 7:

Burn and Hericourt et al. substantially teach the process as applied to claim 6 above. Furthermore, Burn teaches the binding further comprising the Tokenizing Officer storing the signature certificate/private key for the user in the token (par. 44, lines 14-21).

As per claim 8:

Burn and Hericourt et al. substantially teach the process as applied to claim 7 above. Not explicitly disclosed by Burn or Hericourt et al. is the binding further comprising the user unwrapping the signature certificate/private key using the token private key stored in the token. However, Burn teaches the HTP unwrapping the signature certificate/private key stored in the token. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to instead have the user unwrap the information in the token. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 44, lines 14-21.

As per claims 15-18:

The limitations in claims 15-18 are similar in scope to the limitations disclosed in claims

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5-8, thus it are rejected for the same reasons since they are merely components of the system that implement the rejected method claims.

**References Cited, Not Used*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. U.S. Patent No. 5,943,423
2. U.S. Patent No. 6,438,550

The above references have been cited because they are relevant due to the manner in which the invention has been claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825.

The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



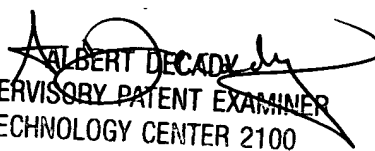
Nadia Khoshnoodi

Examiner

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9/30/2005

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